

**REMARKS**

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-7, 9-15, and 17-29 were pending in the application, of which Claims 1, 6, and 25 are independent. In the Office Action dated April 2, 2007, Claims 1-7, 9-15, and 17-29 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 1-7, 9-15, and 17-29 remain in this application. Applicant hereby addresses the Examiner's rejections in turn.

I. **Examiner Interview Summary**

Applicants thank Examiners Daye and Al-Hashemi for the courtesy of a telephone interview on June 20, 2007, requested by the undersigned to discuss the rejection of the current claims under 35 U.S.C. § 103. During the interview, Applicants asserted that the cited references do not anticipate or render obvious the claims as currently amended. No agreement was reached regarding patentability.

II. **Rejection of Claim 1-5 Under 35 U.S.C. §103(a)**

In the Office Action dated April 2, 2007, the Examiner rejected Claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,859,800 ("Roche") in view of U.S. Patent No. 6,111,985 ("Hullender") and further in view of U.S. Patent No. 5,832,474 ("Lopresti"). Claim 1 has been amended, and Applicant respectfully submits that the amendment overcomes this rejection and adds no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "accepting, by a computer, a search query, where the search query comprises a search query word, and a list of electronic documents, and at least one folder containing the electronic documents in the list of electronic documents." Support for these amendments can be found in the specification at least on page 3, lines 16-21 and page 4, lines 19-28.

In contrast, *Roche* at least does not teach or suggest the aforementioned recitations. For example, *Roche* merely ranking matches based on a number of documents that contain a match and present the matches in order based on the number of matches. (See col. 13, lines 63-66.) For instance, in *Roche*, a match "Windows 95" occurs in the most documents in an example (e.g. five) and is thus presented at the top of a list. (See col. 13, lines 66-67.) Similarly in *Roche*, a match "Windows 2000" occurs in only one document in an example and is therefore presented at the end of the list. (See col. 14, lines 1-2.) Information identifying the document(s) in which a particular match occurs may also be provided in the results. (See col. 14, lines 2-4.) Consequently, *Roche* discloses listing search terms in descending order and returning information identifying where a match occurs. *Roche* does not teach or suggest an electronic document comprising multiple electronic documents and at least one folder containing the multiple electronic documents. This is because in *Roche*, search terms are listed in descending order and information identifying where a match occurs is then returned.

Furthermore, *Hullender* does not overcome *Roche*'s deficiencies. *Hullender* merely discloses recognizing handwritten characters previously entered into a system from a context of subsequent handwritten characters presently being entered into the system. (See col. 2, lines 37-40.) Consequently, *Hullender*, like *Roche*, does not teach or suggest an electronic document comprising multiple electronic documents and at least one folder containing the multiple electronic documents, because *Hullender* teaches recognizing handwritten characters.

Moreover, *Lopresti* does not overcome *Roche*'s and *Hullender*'s deficiencies. *Lopresti* merely discloses a document storage and retrieval system. (See col. 2, lines 18-19.) *Lopresti* permits user-drawn annotations to be readily incorporated into or associated with stored document without requiring duplication of the document. (See col. 2, lines 19-22.) *Lopresti*'s user-drawn annotations can be searched as part of a document retrieval query. (See col. 2, lines 22-23.) These annotations in *Lopresti* become associated with a stored document and may be searched to later retrieve the document. (See col. 2, lines 26-28.) Consequently, *Lopresti* discloses adding annotations to a single document that can be searched. Accordingly, *Lopresti* does not teach or suggest an electronic document comprising multiple electronic documents and at least one folder containing the multiple electronic documents. This is because in *Lopresti*, annotations are incorporated into a single document.

Combining *Roche* with *Hullender* and *Lopresti* would not have led to the claimed invention because *Roche*, *Hullender*, and *Lopresti*, either individually or in combination, at least do not disclose or suggest "accepting, by a computer, a search query, where the search query comprises a search query word, and a list of

electronic documents, and at least one folder containing the electronic documents in the list of electronic documents," as recited by amended Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

Dependent Claims 2-5 are also allowable at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 2-5.

III. Rejection of Claims 6-7 9-15, and 17-29 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected Claims 6-7, 9-15, and 17-29 under 35 U.S.C. §103(a) as being unpatentable over *Roche* in view of U.S. Patent No. 4,832,474 ("Lopresti"). Furthermore, the Examiner rejected Claims 10-11 under 35 U.S.C. §103(a) as being unpatentable over *Roche* in view of *Lopresti* further in view of Software Patent Institute Database of Software Technologies, Published 1997 ("SPI"). Claims 6 and 25 have been amended, and Applicant respectfully submits that these amendments overcome this rejection and add no new matter.

Amended Claim 6 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "accepting, by a computer, a search query comprising a search query word to be sought in the electronic document, a list of electronic documents, and at least one folder containing the documents in the list of electronic documents." Amended Claim 25 includes a similar recitation. In addition, Claim 25 is patentably distinguishable over the cited art for at least the reason it

recites, for example, "wherein the at least one set of characters is selected from the group consisting of an ink character and a text character." Support for these amendments can be found in the specification at least on page 3, lines 16-21 and page 4, lines 19-28.

In contrast, *Roche* at least does not teach or suggest the aforementioned recitations. For example, *Roche* merely ranking matches based on a number of documents that contain a match and present the matches in order based on the number of matches. (See col. 13, lines 63-66.) For instance, in *Roche*, a match "Windows 95" occurs in the most documents in an example (e.g. five) and is thus presented at the top of a list. (See col. 13, lines 66-67.) Similarly in *Roche*, a match "Windows 2000" occurs in only one document in an example and is therefore presented at the end of the list. (See col. 14, lines 1-2.) Information identifying the document(s) in which a particular match occurs may also be provided in the results. (See col. 14, lines 2-4.) Consequently, *Roche* discloses listing search terms in descending order and returning information identifying where a match occurs. *Roche* does not teach or suggest an electronic document comprising multiple electronic documents and at least one folder containing the multiple electronic documents. This is because in *Roche*, search terms are listed in descending order and information identifying where a match occurs is then returned.

Moreover, *Lopresti* does not overcome *Roche*'s and *Hullender*'s deficiencies. *Lopresti* merely discloses a document storage and retrieval system. (See col. 2, lines 18-19.) *Lopresti* permits user-drawn annotations to be readily incorporated into or associated with stored document without requiring duplication of the document. (See

col. 2, lines 19-22.) *Lopresti*'s user-drawn annotations can be searched as part of a document retrieval query. (See col. 2, lines 22-23.) These annotations in *Lopresti* become associated with a stored document and may be searched to later retrieve the document. (See col. 2, lines 26-28.) Consequently, *Lopresti* discloses adding annotations to a single document that can be searched. Accordingly, *Lopresti* does not teach or suggest an electronic document comprising multiple electronic documents and at least one folder containing the multiple electronic documents. This is because in *Lopresti*, annotations are incorporated into a single document.

Combining *Roche* with *Lopresti* would not have led to the claimed invention because *Roche* and *Lopresti*, either individually or in combination, at least do not disclose or suggest "accepting, by a computer, a search query comprising a search query word to be sought in the electronic document, a list of electronic documents, and at least one folder containing the documents in the list of electronic documents," as recited by amended Claim 6. Amended Claim 25 includes a similar recitation. In addition, *Roche* and *Lopresti*, either individually or in combination, at least do not disclose or suggest "wherein the at least one set of characters is selected from the group consisting of an ink character and a text character," as recited by amended Claim 25. Accordingly, independent Claims 6 and 25 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 6 and 25.

Dependent Claims 7, 9-15, 17-24, and 26-29 are also allowable at least for the reasons described above regarding independent Claim 6 and 25, and by virtue of their respective dependencies upon independent Claims 6 and 25. Accordingly,

Applicant respectfully requests withdrawal of this rejection of dependent Claims 7, 9-15, 17-24, and 26-29.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our Deposit Account No. 13-2725.

Respectfully submitted,  
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